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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/821,736

04/09/2004

Hisashi Takeuchi

MM4719

1520

7590

07/21/2006

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EXAMINER

BEAUCHAINE, MARK J

ART UNIT

PAPER NUMBER

3653

DATE MAILED: 07/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/821,736	TAKEUCHI ET AL.	
	Examiner	Art Unit	
	Mark J. Beauchaine	3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/5/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to the Applicant's amendment dated 3 April 2006. The Applicant's amendment of claims 1 and 6 to overcome the 35 USC 112, second paragraph rejection of previous Office action dated 29 December 2005 is acknowledged. Accordingly, said rejection of is hereby withdrawn.

Information Disclosure Statement

Receipt of the Information Disclosure Statement (IDS) submittal dated 5 June 2006 is acknowledged. However, the first item of the Foreign Patent Documents section fails to conform to the requirements of 37 CFR 1.98(3) that requires that the Applicant provide either a "concise explanation of the relevance . . . of each patent, publication, or other information listed that is not in the English language" or a copy of a "written English-language translation of a non-English-language document" if it is available to the Applicant.

No explanation of relevance or English-language translation related to the above-mentioned foreign patent document has been received. Accordingly, said document has been placed in the record of file but has not been considered and the related item reference in the PTO-1449 form has been lined through.

Claim Objections

Claims 5 and 6 are objected to because of the following informalities:

The terms "a printed note information" (claim 5, line 2 and line 3 (two occurrences)), "being resulted" (claim 5, line 3) and "a machine information" (claim 6, line 3) are improper grammar.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The terms "classifying" (line 4) and "to save" are ambiguous since it is unclear what element(s) is/are doing the classifying and saving, respectively.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent Application Publication Number US 2004.0084521 A1 by Nagayoshi et al ("Nagayoshi") in view of Patent Number 4,524,268 by Fukatsu ("Fukatsu"). Nagayoshi discloses user recognition unit 203, inlet unit 101, dispensing unit 140, identifying unit 103, temporary money holder 110, storage cells 120, 121 and 122 and rejection unit 101. Furthermore, genuine notes (para. 0028, line 6 thru para. 0029, line 6) as well as unidentifiable/unclassified notes (para. 0029, lines 19-23) are transported to the temporary money holder 110. Also, rejected notes are returned to the user via transport device 141 to rejection unit 101 (para. 0029, lines 1-4).

Fukatsu teaches temporary money holder 21 that temporarily stores notes determined to be counterfeit via identifying unit 20. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the counterfeit note temporary storage feature of Fukatsu into the apparatus of Nagayoshi to prevent counterfeit notes from being deposited into a secure portion of the apparatus.

Regarding claim 4, the identifying unit 101 of Nagayoshi reads serial numbers (para. 0029, line7-11).

Regarding claims 5-7, Nagayoshi further discloses memory 132 that stores note and transaction information. Nagayoshi further discloses communication between host computer 502 and the apparatus (ATM). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate machine (ATM) information in memory 132 to provide machine identification information to host

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computer 132 to distinguish one particular machine from a plurality of machines in a network.

Claim Rejections - 35 USC § 103

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagayoshi in view of Fukatsu as applied to claim 1 above, and further in view of Patent Number US 6,874,682 B2 by Utz et al ("Utz"). Utz teaches storage cell 100 that receives notes classified as counterfeit via identifying unit 88 (column 23, lines 21-33). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the counterfeit retention feature of Utz into the apparatus of Nagayoshi to provide an effective means of preventing counterfeit notes from reentering circulation.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagayoshi in view of Fukatsu as applied to claim 7 above, and further in view of Utz. Nagayoshi discloses database apparatus 502. The apparatus taught by Utz collects user information related to counterfeit sheets (column 23, lines 58-63), said information is transmitted and compared with similar data of other machines (column 21, lines 1-8). A database apparatus and a trace unit are inherent in such a data process. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the counterfeit note data processing features of Utz into the apparatus of Nagayoshi because the identification of apparatus users that deposit counterfeit notes

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permits apparatus operators to notify said users of the existence of said counterfeit notes.

Response to Arguments

Applicant's arguments with respect to claims 1-3, 5 and 6 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark J. Beauchaine whose telephone number is (571)272-6934. The examiner can normally be reached on 8:00AM through 5:00PM Mondays through Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen Lillis can be reached on (571)272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mjb

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